APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,123	08/21/2003	Richard D. Dettinger	ROC920030105US1	7110

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EXAMINER
CHOJNACKI, MELLISSA M

ART UNIT	PAPER NUMBER
2164	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/645,123	DETTINGER, RICHARD D. ; ET AL.
	Examiner	Art Unit	
	Mellissa M. Chojnacki	2164	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 January 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7,18-21 and 30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-7,18-21 and 30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Remarks

1.   In response to communications filed on January 10, 2007, claims 8-17, and 22-29 have been cancelled; claims 1-5, 18 and 30have been amended, and no new claims have been added. Therefore, claims 1-6, 18-21 and 30 are presently pending in the application.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.   Claims 1-7 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 30 are not limited to a method that runs on a computer medium. As such, the claim is not limited to statutory subject matter and is therefore non-statutory. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d

at 1759. When functional descriptive material is recorded on some computer-readable

medium, it becomes structurally and functionally interrelated to the medium and will be

statutory in most cases since use of technology permits the function of the descriptive

material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d

1031, 1035 (Fed. Cir. 1994)

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-7, 18-21 and 30 are rejected under 35 U.S.C. 102(e) as being

anticipated by Gupta et al. (U.S. Patent No. 6,956,593).

As to claim 1, Gupta et al. teaches a method for annotating a query component,

the query component being a component of a query (See column 2, lines 43-47; column

12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42), comprising:

receiving a selection of the query component (See column 2, lines 43-47; column

12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42);

receiving an annotation and a request to associate the annotation with the

selected query component via an interface allowing a user to create the annotation and

request the association with the selected query component (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42); and

storing, on a storage medium, the annotation with a reference to the selected query component (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42).

As to claim 2, Gupta et al. teaches wherein the selected query component comprises one or more query conditions (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42).

As to claim 3, Gupta et al. teaches wherein the selected query component comprises one or more instance values of data, where instance values are any particular value inputted in a field (See *).

As to claim 4, Gupta et al. teaches providing an interface for building the query by specifying query components (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42); and wherein receiving an indication of the selected query component comprises receiving a user selection of one or more query components specified, via the interface, for use in a query (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42).

As to claims 5 and 19, <u>Gupta et al.</u> teaches providing an interface allowing the user to create a suggested substitution for the selected query component, the suggested substitution being selectable to replace the selected query component (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42); wherein the operations further comprise providing an interface allowing the user to create a suggested substitution for the selected query component (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42).

As to claim 6, <u>Gupta et al.</u> teaches wherein storing the annotation with a reference to the one or more query components comprises: decomposing the query component into one or more fragments; and storing the fragments with the annotation (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42*).

As to claims 7 and 20, <u>Gupta et al.</u> teaches wherein storing the annotation with a reference to the one or more query components comprises: substituting a parameter marker for an instance value contained in the query component; and storing the query component with the parameter marker with the annotation (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42*); wherein storing the annotation with a reference to the one or more query components comprises: substituting a parameter marker for an instance value contained in the query component; and storing the query component with the parameter marker with the

annotation (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42*).

As to claim 18, Gupta et al. teaches a computer-readable storage medium containing a program for annotating query components which, when executed by a processor (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42), performs operations comprising:

receiving a selection of a query component, the selected query component being a component of a query (column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42);

receiving an annotation and a request to associate the annotation with the selected query component via an interface allowing a user to create an annotation to associate with the selected query component (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42); and

storing, on a storage device, the annotation with a reference to the selected query component (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42).

As to claim 21, Gupta et al. teaches wherein the operations further comprise: monitoring one or more query components specified for use in a query (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42);

searching for annotations associated with the one or more query components
(See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16,
lines 19-42); and

providing an indication of one or more annotations, if found, associated with the
one or more query components (See column 2, lines 43-47; column 12, lines 39-59;
column 15, lines 34-45; column 16, lines 19-42).

As to claim 30, Gupta et al. a method (See column 2, lines 43-47; column 12,
lines 39-59; column 15, lines 34-45; column 16, lines 19-42), comprising:

receiving a selection of the query component (See column 2, lines 43-47; column
12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42);

providing an interface allowing a user to create an annotation and request an
association between the annotation and the selected query component (See column 2,
lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42);

in response to receiving the annotation and the request, storing, on a storage
medium, the annotation with a reference to the selected query component (See column
2, lines 43-47; column 12, lines 39-59; column 15, lines 34-45; column 16, lines 19-42);

monitoring one or more query components specified for use in a query being
composed in a query building interface (See column 2, lines 43-47; column 12, lines 39-
59; column 15, lines 34-45; column 16, lines 19-42);

searching for stored annotations associated with the one or more query

components (See column 2, lines 43-47; column 12, lines 39-59; column 15, lines 34-

45; column 16, lines 19-42); and

outputting an indication of one or more annotations, if found, associated with the

one or more query components (See column 2, lines 43-47; column 12, lines 39-59;

column 15, lines 34-45; column 16, lines 19-42).

Response to Arguments

6.   Applicant's arguments filed on 10-January -2007, with respect to the rejected

claims 1-6, 18-21 and 30 have been fully considered but they are not found to be

persuasive:

In response to applicants' arguments regarding the 35 USC § 101, the

arguments have been fully considered but are not found to be persuasive, because the

applicant has not amended the claims to reflect that the method disclosed in claims 1

and 30 are run on a computer readable medium and therefore the claims are not

statutory. Furthermore, examiner states they are not "not a series of steps or acts to be

a process nor are they a combination of chemical compounds to be a composition of

matter. As such, they fail to fall within a statutory category. They are, at best, functional

descriptive material *per se"* because "Descriptive material can be characterized as

either "functional descriptive "When functional descriptive material is recorded on some

computer-readable medium, it becomes structurally and functionally interrelated to the

medium and will be statutory in most cases since use of technology permits the function

of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84,

32 USPQ2d 1031, 1035 (Fed. Cir. 1994)".

7.   Applicant's arguments filed on January 10, 2007, with respect to the rejected

claims in view of the cited references have been considered but are moot in view of

applicant's amended claims necessitate new ground(s) of rejection.

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mellissa M. Chojnacki whose telephone number is (571) 272-4076. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 9, 2007
Mmc

SAM RIMELL
PRIMARY EXAMINER